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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,468	12/12/2003	David A. Franklin	085314.015	9594

7590 10/19/2004
Jeffrey S. Whittle
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EXAMINER


FISHMAN, MARINA

ART UNIT	PAPER NUMBER
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2832

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/734,468	FRANKLIN ET AL.	
	Examiner	Art Unit	
	Marina Fishman	2832	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-22 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/12/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

General status

1. This is a First Action on the Merits. Claims 1 - 22 are pending in the case and are being examined.

Claim Objections

2. Claims 2 – 10, 12 - 20 are objected to because of the following informalities:

In claims 2 – 10, "A portable" should be corrected as –The portable--;

In claims 12 – 20 "An operation" should be corrected as –The operation--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11 –20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of the claim 11 "an operation counter assembly **adapted to** be positioned on a circuit interrupting appartus..." suggests that only "an operation counter assembly" is being positively claimed and the "circuit interrupting assembly" is not being positively claimed. For purposes of examination, interpreted the claim 11 to include the circuit interrupting assembly along with all the components.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Nicolai et al. [US 6,300,585].

The method steps of the claim 21 are necessitated by the device structure and disclosed by Nicolai et al. [Figure 1 – 13]. Nicolai et al. disclose an operation counter assembly including an operation counter housing [60, 50] containing an operation counter [10] and an operation counter actuating switch [34] and having an operation counter housing back side opening adapted to interface with a reset plunger [30,32] protruding through a main housing body outer surface of the circuit interrupting apparatus and an operation counter housing front side opening for allowing passage of the reset plunger through the operation counter housing; installing an operation counter actuating switch actuator to the reset plunger; and fastening the operation counter housing to the main housing body of the circuit interrupting apparatus.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 - 3, 6, 7 - 10, 11 - 13, 16, 17 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. [US 5,861,595] in view of Nicolai et al. [US 6,300,585].

Wood et al. disclose a portable circuit interrupting apparatus [Figures 1 - 4] having:

- a main housing [34] having a main housing body including a main housing body outer surface and a longitudinal axis [35];
- a sleeve [36] including a sleeve main body having a sleeve main body outer surface and coaxially mounted within the main housing so as to be slidable between an extended position and a retracted position, a spring assembly [38] for biasing the sleeve main body from between the extended position toward the retracted position, and a reset plunger opening positioned in a medial portion of the main sleeve body [Column 4, lines 45 - 55];
- a shunting circuit assembly [74] having a ring engaging terminal [40] adapted to electrically connect to a ring-like conducting part of a circuit isolating device and a hook engaging terminal [68] adapted to electrically connect to a hook-like conducting part of a circuit isolating device, a shunting circuit segment connected between the ring engaging terminal and the hook engaging terminal and positioned within the housing and sleeve to interrupt an electrical connection

between the ring-like conducting part and hook-like conducting part responsive to movement of the sleeve from the retracted position to the extended position [Column 5, lines 48 – 60];

- a reset plunger assembly including a reset plunger and connected to a medial portion of the main housing body, adapted to extend at least portions of the reset plunger through the reset plunger opening in the medial portion of the main sleeve body when in a non-reset and biased inward lock position to releasably lock the sleeve in the extended position so as to obtain and maintain an electrical clearance between the ring engaging terminal and the hook engaging terminal when the ring engaging terminal and the hook engaging terminal engage a circuit isolating device and when the main sleeve body is positioned in the extended position, and adapted to reset outwardly responsive to outwardly biased pressure by a user and outward pressure from the main sleeve outer surface when the sleeve main body is in an at least partially retracted position Columns 5 – 7].

Regarding Claims 1, 11, 21 and 22, Wood et al. disclose the instant claimed invention except for an operation counter assembly with an operation counter. Nicolai et al. disclose an operation counter assembly with an operation counter [10; Abstract]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an operation counter assembly with an operation counter in

Wood et al., as suggested by Nicolai et al., in order to improve scheduling of maintenance and inspection [Column 2, lines 28 – 32].

Regarding Claim 2, 3, 6, 7 - 10 Nicolai et al. disclose the operation counter assembly with the operation counter [Figures 1 – 14] having a rotational counter incrementor [112, Figure 13] to increment a count of the operation counter; a roll pin [Figure 13] connected to the reset plunger and click-over lever [114]; a counter incrementor switch [34; Column 3, lines 47 +, and Column 4, lines 25 – 31].

Regarding Claim 23, the method steps are necessitated by the device structure and disclosed by Wood et al. in view of Nicolai et al.

Allowable Subject Matter

9. Claims 4, 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 14 and 15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lindell [US 2,816,980], Scherer et al. [US 5,502,427], Harvey [US 3,727,019], Tjebben [US 3,958,156]. Applicant also should consider these references in response to this office action. Should issue arise concerning the rejection presented

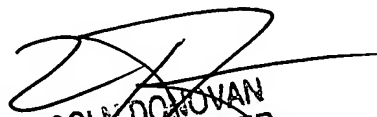
above, these references may be relied upon in a subsequent action to support the lack of novelty or obviousness of claimed subject matter to one of ordinary skill in the art.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Fishman whose telephone number is 571-272-1991. The examiner can normally be reached on 7-5 M-T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Fishman
October 4, 2004


LINCOLN DONOVAN
PRIMARY EXAMINER
GROUP 2100